

**REMARKS**

Claims 1-14, 16-90, 103 and 104 are pending in this Application. Claims 1, 16, 30, 44, 60 and 103 are independent claims. By this Amendment, claims 15, 91 and 94-102 are cancelled without prejudice or disclaimer. Claims 103 and 104 are added. Claims 1, 3, 6, 8, 16, 18, 21, 23, 30, 32, 35, 37, 44, 45, 47, 60, 62 and 75 are amended. No new matter is added.

**Claim Objections**

Claims 75 and 99 are objected to due to informalities. Specifically, claim 75 is objected to for failing to recite “the” prior to storage medium. Claim 75 is amended to address the error. Claim 99 is cancelled as being a substantial duplicate of claim 97. Thus, withdrawal of the objections is respectfully requested.

**Rejections under 35 U.S.C. §101**

Claims 30-43, 78, 79, 83-90, 44-59, 80, 81, 91 and 94-102 stand rejected under 35 U.S.C. §101 for allegedly being directed to non-statutory subject matter. The rejection is respectfully traversed.

It is alleged that all of the rejected claims “recite a computer program only” and therefore are non-statutory subject matter. Applicant respectfully disagrees with the characterization of claim 83 as a computer program as the claim is clearly drawn to an apparatus. Further, claims 30-43, 78, 79 and 84-90 are drawn to process claims which, according to 35 USC §101, is statutory subject matter.

Regarding independent claims 30 and 44, it is admitted that a process or method is claimed but because “the machine is not required, this claim is considered to be a computer program per se.” It is unclear why the Examiner considers the method claims to be a computer programs simply because a machine is allegedly not required.

Further, according to recent decisions in the Court of Appeals for the Federal Circuit (CAFC) and the Board of Appeals and Patent Interferences (BPAI) the applicable test for determining if a method claim recites non-patentable subject matter is the “machine or transformation test.” Applicant assumes that the Examiner may intend to mean that the method claims recite non-patentable subject matter because they are not tied to a specific machine or perform a transformation.

Based on the forgoing assumption, Applicant respectfully points out that independent claims 30 and 44 are tied to a machine and therefore meet the “machine or transformation test” discussed above. To further clarify the claimed subject matter of claims 30 and 44 are amended.

Claims 91 and 94-102 are cancelled, and therefore, the rejection of those claims is moot. As all of the remaining rejected claims recite patentable subject matter, withdrawal of the rejection is respectfully requested.

**Rejections under 35 U.S.C. §112**

Claims 3, 6, 8, 15, 16, 18, 21, 23, 32, 35, 37, 45, 47, 62, 75-83, 98 and 100 are rejected under 35 USC §112, second paragraph, for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. As claims 15, 98 and 100 are cancelled, the rejection of those claims is moot. The rejection of claims 3, 6, 8, 15, 16, 18, 21, 23, 32, 35, 37, 45, 47, 62 and 75-83 is respectfully traversed.

Regarding claims 3, 6, 8, 18, 21, 23, 32, 35, 37, 45, 47 and 62, it is alleged that the claims are indefinite because they recite “prohibit operation of at least one of the software and the machine upon determining that the comparison does not match” and that “since the machine is already operating in order to prohibit itself from operating, it was in fact not prohibited from operating.”

Applicant respectfully refers the Examiner to the claim language of dependent claim 3, for example, which recites “the device is adapted to prohibit operation of at least one of the software and the machine upon determining that the comparison does not match.” Thus, it is the device which prohibits operation of the machine and not the machine from prohibiting operation of itself. However, in an effort to expedite prosecution of the present application, the claims are amended for further clarification.

Regarding claim 16, the claim is amended to recite that both of the first code segment and the second code segments are stored in the user machine. Claim 16 is also further amended to further clarify the claimed subject matter.

Regarding claims 75-83, it is alleged that the “specification provides that a software option is software; therefore it is unclear how the specification can say that a software option is software and the claims can say that a software option is different than software.”

Applicants respectfully refer the Examiner to at least paragraphs [0020]-[0025], [0047], [0049], [0050] of the specification and Figs 1-7 for clarification. Applicant submits that one of

skill in the art would readily understand the distinctions and relationship between software and a software option upon reading the specification. For example, as recited in the specification, the term software option is used throughout the application to mean some type of software for interacting with existing software to be licensed. The software option is for licensing a number of prepaid uses of software for a machine. The software option can include unique and unchangeable information identifying the machine to be licensed, and information for measuring a number of uses of the machine. The information, such as the software option for example, is preferably stored as a license.dat file, and includes unique and unchangeable information identifying the machine, and information for measuring a number of uses of the software on the machine. Based upon the stored information, a license for a number of prepaid uses of the software can be locally granted on the machine. The software and the software option can also be integrated and stored and used together as one.

As the terms are clear in the specification and the terms in the claims take on the definitions provided in the specification, the claims are not indefinite. Because the claims meet the requirements of 35 USC §112, second paragraph, withdrawal of the rejections is respectfully requested.

### **Rejections under 35 U.S.C. §103**

Claims 1-11, 15-26, 30-40, 44-49, 51-64, 66-91 and 94-101 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication 2004/0205261 to Osada in view of U.S. Patent 6,708,157 to Stefik, et al. (Stefik). As claims 15, 91 and 94-101 are cancelled, the rejection of those claims is moot. The rejection of the remaining claims is respectfully traversed.

Osada relates to an image forming apparatus that has a license management module that acquires license information including an apparatus identification information specifying the apparatus and a program specifying information for specifying a program as a program to be executed at the start of the apparatus, from an external device. When the module determines that the program specified by program specifying information has not been set to a program to be executed at the start of the apparatus, it sets the program to a program to be executed.

The image forming apparatus 100 is a multifunction printer (MFP) and includes a controller 101 that controls the overall operation of the MFP 100 (fax, printer, scanning

functions). A control program that controls the controller 101 is stored in the ROM 203 or the DISK 204. As shown in FIG. 5, the main part of the software of the controller 101 includes a program management module 501, the start program identification module 502 and a license management module 503. The license management module 503 communicates with the operating section 106 or the communication section 102, and executes predetermined processes.

It is alleged in the Office Action that Osada discloses a storage medium at paragraph [0012] and a device in the machine for locally granting a license (license management module 503). The storage medium described at paragraph [0012] refers to the ROM 203 or the DISK 204 of the controller 101 (see paragraph [0063]). However, in contrast to the rejected claims, neither the ROM 203 nor the DISK 204 include licensing information allowing at least one use of software on the machine, the licensing information including unique and unchangeable information identifying the machine and information for measuring a number of uses of the software on the machine.

Rather, in Osada, the licensing information is stored in a PC separate and remote from the MFP. For example, the licensing information is stored in a PC 302 that is in communication with the MFP 100 via a network 305 (Fig. 3; paragraph [0092]). Thus, the storage medium that stores the licensing information is not in the same machine as the license management module 503. Further, because the storage medium and the license management module 503 are remote from one another, the license management module 503 is not adapted to locally grant a license based on information stored in the storage medium of the remote machine (PC 302).

Thus, Osada fails to disclose or suggest the features as alleged in the Office Action. Moreover, Stefik fails to overcome the deficiencies of Osada. Stefik relates to a system for controlling the distribution and use of digital works using a "digital ticket." The digital ticket is used to enable the ticket holder to exercise usage rights specifying the requirement of the digital ticket. For example, a digital ticket may be specified in a copyright of a digital work, so that exercise of the copyright requires the party that desires a copy of the digital work be in possession of the necessary digital ticket. After a copy of the digital work is successfully sent to the requesting party, the digital ticket is "punched" to indicate that a copy of the digital work has been made. When the ticket is "punched" a predetermined number of times, it may no longer be used. Thus, in contrast to the rejected claims, Stefik fails to disclose a device in the machine, adapted to locally grant a license for the number of prepaid uses of the software on the machine based upon the information stored in the storage medium. Rather, in Stefik, a copyright to a

particular digital work is granted at the repository and the digital work is sent to the holder of the digital ticket at a remote location. Further, there is nothing in Stefik that discloses a license for a number of prepaid uses (executions) of the software on the machine. Rather, Stefik only discloses grant of a copy right to a prepaid upgrade of a software product or a number of copies that may be made of the digital work. Finally, in Stefik the grant of the right to copy is provided remotely from the repository and not locally from a device in the machine.

Thus, the combination of references fails to disclose the claimed apparatuses, methods and computer readable media recited in the rejected claims. As the combination of references does not render the pending claims obvious, withdrawal of the rejection is respectfully requested.

Claims 12-14, 27-29, 41-43, 50, 65 and 102 are rejected under 35 U.S.C. §103(a) as being unpatentable over Osada in view of Stefik and further in view of U.S. Patent 6,816,842 to Singh et al. (Singh). As claim 102 is cancelled, the rejection of that claim is moot. The rejection of the remaining claims is respectfully traversed.

Claims 12-14, 27-29, 41-43, 50 and 65 are allowable for their dependency on their respective base claim, as well as for the additional features recited therein. As such, withdrawal of the rejection is respectfully traversed.

### **New Claims**

None of the applied references, whether considered alone or in combination, disclose or suggest, a computer readable medium for granting a prepaid license on a user machine, the computer readable medium having computer executable instructions stored thereon to configure the user machine to perform the steps comprising storing licensing information on a storage device in the user machine, the licensing information including at least one prepaid use of software on the user machine, the information being unique and unchangeable information identifying the machine, and information for measuring a number of uses of the software on the machine; and locally granting a license for the number of prepaid uses of the software on the user machine, based upon the stored information, as recited in new claim 103.

The combination of references also fails to disclose or suggest, examining the stored licensing information to determine a number of prepaid uses and the unique and unchangeable information identifying the user machine; comparing information identifying the user machine to

the unique and unchangeable information stored on the storage device; determining a remaining number of uses of the software on the user machine and comparing the remaining number of uses to the number of prepaid uses; and granting a license for use of the software on the user machine for the number of prepaid uses remaining upon the information identifying the machine matching the unique and unchangeable information identifying the user machine and upon the number of uses being determined to be less than the number of prepaid uses, as recited in new claim 104.

**CONCLUSION**

Accordingly, in view of the above amendments and remarks, reconsideration of the objections and rejections and allowance of each of the pending claims in connection with the present application is earnestly solicited.

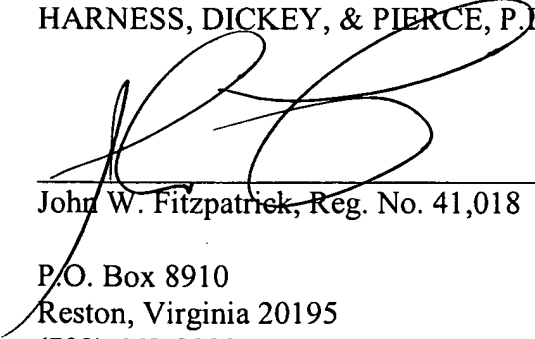
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Fitzpatrick at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKY, & PIERCE, P.L.C.

By

  
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